

### **REMARKS**

The Examiner rejected claims 1-9, 11, 13-15, 21-29, 31 and 33-35 under 35 U.S.C. § 102(b) as allegedly being anticipated by CHECKBOOK (“Health Clubs,” Washington Consumers’ CHECKBOOK, Volume 12, Fall 2001 / Winter 2002, Reprint provided by Applicant in IDS submitted 01/22/2004).

The Examiner rejected claims 10, 12, 17-20, 30, 32 and 37-40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over CHECKBOOK.

The Examiner rejected claims 16 and 36 under 35 U.S.C. § 103 as allegedly being unpatentable over CHECKBOOK.

The Examiner rejected claims 10, 12, 17-20, 30, 32 and 37-40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over CHECKBOOK in view of McLuhan, (McLuhan, Robert, “Brands put service under the spotlight: Companies are enlisting mystery shoppers to test the quality of their offering,” Marketing, February 21, 2002).

Applicant respectfully traverses the § 102 and § 103 rejections with the following arguments.

**35 U.S.C. § 102(b)**

The Examiner rejected claims 1-9, 11, 13-15, 21-29, 31 and 33-35 under 35 U.S.C. § 102(b) as allegedly being anticipated by CHECKBOOK (“Health Clubs,” Washington Consumers’ CHECKBOOK, Volume 12, Fall 2001 / Winter 2002, Reprint provided by Applicant in IDS submitted 01/22/2004).

Applicant respectfully contends that CHECKBOOK does not anticipate claims 1 and 21, because CHECKBOOK does not teach each and every feature of claims 1 and 21.

As an example of why CHECKBOOK does not anticipate claims 1 and 21, CHECKBOOK does not teach the features:

“inspecting the facility by at least one inspector through at least one on-site inspection of the facility by the at least one inspector; and rating the facility using a plurality of rating factors derived from the at least one on-site inspection” (claim 1); and

“an inspection team including at least one inspector, said team adapted to inspect the facility through at least one on-site inspection of the facility by the at least one inspector; and an organization adapted to rate the facility using a plurality of rating factors derived from the at least one on-site inspection” (claim 21).

In CHECKBOOK, the health clubs are not rated on the basis of at least one on-site inspection of the facility by the at least one inspector as claimed, but are instead based on other methods as follows.

See CHECKBOOK, page 13, top portion of left column: “Customer survey scores reported on our tables are from a survey in which about 70,000 questionnaires per year are sent to

*Consumer Reports* and CHECKBOOK subscribers, and about 7,000 per year are returned”.

See CHECKBOOK, page 13, bottom three lines of left column to first four lines of middle column: “To gather much of the other information on our tables, we surveyed the firms, In general, our researchers surveyed the firms by phone ..., but in some cases data were collected by mail, or phone responses were confirmed by follow-up.

If the Examiner is arguing that the users of the health clubs are the inspectors, Applicant responds that CHECKBOOK does not teach that the users performed any inspection while on-site (i.e., while at the health club). The questionnaires were sent to the users and the response of the users to the questions on the questionnaire did not occur while the users were physically present in the health clubs. The Examiner has not presented any evidence allegedly showing that the health club users consciously inspected anything relevant to the rating factors while physically present at the health club. If the Examiner is alleging that the health club users performed unconscious inspections relevant to the rating factors while physically present at the health club, Applicant asserts any such allegation of unconscious inspections is speculative and cannot be proved. In other words, the only function performed by the users of the health in assessing the rating factors occurred offsite when the users utilized their memory to determine their assessment with respect to the rating factors, which is not an on-site inspection.

If the Examiner is arguing that the surveyors are the inspectors (which the Examiner argues in relation to claims 15 and 35), Applicant responds that the surveyors collected the survey responses off-site and therefore are not disclosed as having made any on-site inspection, as discussed *supra*.

Applicant does not know what reasoning the Examiner used to conclude that

CHECKBOOK allegedly teaches the preceding feature of claims 1 and 21. Applicant cannot read the Examiner's mind. Accordingly, Applicant respectfully requests that the Examiner explain specifically how CHECKBOOK allegedly teaches the preceding feature of claims 1 and 21.

Based on the preceding arguments, Applicant respectfully maintains that CHECKBOOK does not anticipate claims 1 and 21, and that claims 1 and 21 are in condition for allowance. Since claims 2-9, 11 and 13-15 depend from claim 1, Applicant contends that claims 2-9, 11 and 13-15 are likewise in condition for allowance.

In addition with respect to claims 2 and 22, CHECKBOOK does not teach the feature: "wherein the rating factors include comradery experienced by users of the facility".

The Examiner argues that CHECKBOOK, page 4 discloses friendliness as a rating factor.

In response, Applicant respectfully contends that "friendliness" is not a synonym for "comradery" and "friendliness" does not inherently imply "comradery".

Therefore, CHECKBOOK does not anticipate claims 2 and 22.

In addition with respect to claims 3 and 23, CHECKBOOK does not teach the feature: "wherein the rating factors further include healthfulness of the environment of the facility, competence of trainers utilized by the facility for assisting and guiding the users, and quality, quantity, and variety of exercise equipment available to the users".

The Examiner argues: "As per Claims 3 and 23, CHECKBOOK discloses wherein the

rating factors include healthfulness of the environment of the facility (pg.4, Cleanliness), competence of trainers utilized by the facility for assisting and guiding the users (pg.4, Quality of instructors), and quality, quantity, variety of exercise equipment available to the users (pg.4, Adequacy of facilities/equipment for demand; pg.6).”

In response, Applicant respectfully contends that CHECKBOOK page 6 does not teach “Adequacy of facilities/equipment for demand” as the Examiner alleges. Moreover, Applicant asserts that a rating factor of “Adequacy of facilities/equipment for demand” is not a rating factor of “quality, quantity, and variety of exercise equipment available to the users”.

Therefore, CHECKBOOK does not anticipate claims 3 and 23.

In addition with respect to claims 4 and 24, CHECKBOOK does not teach the feature: “wherein the rating factors further include availability of products and services supplied by the facility for use by the users in support of at least one of exercise and health goals of the users.”.

The Examiner argues: “As per Claims 4 and 24, CHECKBOOK discloses wherein the rating factors include availability of products and services supplied by the facility for use by the users in support of at least one of exercise and health goals of the users (pg.4, Adequacy of facilities/equipment for demand; pg.6).”

In response, Applicant respectfully contends that CHECKBOOK, page 6 does not teach “Adequacy of facilities/equipment for demand” as the Examiner alleges. Moreover, Applicant asserts that a rating factor of “Adequacy of facilities/equipment for demand” is not a rating factor of “availability of products and services supplied by the facility for use by the users in support of at least one of exercise and health goals of the users”.

Therefore, CHECKBOOK does not anticipate claims 4 and 24.

In addition with respect to claims 8-9 and 28-29, CHECKBOOK does not teach the feature: “wherein publishing the overall rating includes publishing the overall rating on an Internet website”.

The Examiner argues: “As per Claims 8 and 28, CHECKBOOK discloses wherein publishing the overall rating includes publishing the overall rating on an Internet website (results available through CHECKBOOK Publications website, [www.checkbook.org](http://www.checkbook.org)).”

In response, Applicant respectfully contends that CHECKBOOK does not teach that “results [are] available through CHECKBOOK Publications website, [www.checkbook.org](http://www.checkbook.org)”.

Therefore, CHECKBOOK does not anticipate claims 8-9 and 28-29.

In addition with respect to claims 11 and 31, CHECKBOOK does not teach the feature: “wherein the overall rating is a weighted arithmetic average of the rating factors”.

The Examiner argues: “As per Claims 11 and 31, CHECKBOOK discloses wherein the overall rating is a weighted arithmetic average of the rating factors (pg.13, Top Ratings determined through a weighted scoring system).”

In response, Applicant respectfully contends that a weighted scoring system does not imply a weighted arithmetic averaging. For example, a weighted scoring system could be based on weighted geometrical averaging.

Therefore, CHECKBOOK does not anticipate claims 11 and 31.

In addition with respect to claims 14 and 34, CHECKBOOK does not teach the feature: “wherein the at least one on-site inspection includes an unscheduled inspection by the at least one inspector”.

The Examiner argues: “As per Claims 14 and 34, CHECKBOOK discloses wherein the at least one on-site inspection includes an unscheduled inspection by the at least one inspector (pg. 13, surveys are based on unscheduled unannounced visits to the health club).”

In response, Applicant respectfully contends that there is no teaching anywhere in CHECKPOINT of unscheduled unannounced visits to the health club by anyone.

Therefore, CHECKBOOK does not anticipate claims 14 and 34.

In addition with respect to claims 15 and 35, CHECKBOOK does not teach the feature: “wherein the at least one inspector consists of a plurality of inspectors”.

The Examiner argues: “As per Claims 15 and 35, CHECKBOOK discloses wherein the at least one inspector consists of a plurality of inspectors (pgs. 1 and 13, surveyors).”

In response, Applicant respectfully contends that the surveyors collected the survey responses off-site and therefore are not disclosed as having made any on-site inspection, as discussed *supra*.

Therefore, CHECKBOOK does not anticipate claims 15 and 35.

**35 U.S.C. § 103(a): CHECKBOOK - Claims 10, 12, 17-20, 30, 32, 37-40**

The Examiner rejected claims 10, 12, 17-20, 30, 32 and 37-40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over CHECKBOOK.

Since claims 10, 12, and 17-20 depend from claim 1, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintains that claims 10, 12, and 17-20 are not unpatentable over CHECKBOOK under 35 U.S.C. §103(a).

Since claims 30, 32 and 37-40 depend from claim 21, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintains that claims 30, 32 and 37-40 are not unpatentable over CHECKBOOK under 35 U.S.C. §103(a).

In addition with respect to claims 10 and 30, CHECKBOOK does not teach or suggest the feature: “wherein the overall rating is an unweighted arithmetic average of the rating factors”.

The Examiner argues: “As per Claims 10 and 30, CHECKBOOK fails to expressly disclose wherein the overall rating is an unweighted arithmetic average of the rating factors... However, CHECKBOOK does disclose generating an overall rating of a Health Club through the use of subjectively weighted scoring system (pg. 13, Top ratings), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set all weightings as equal, which would be equivalent to no weighting system.”

In response, Applicant respectfully contends that the “Top Ratings” section on page 13 of CHECKPOINT does not disclose the preceding feature claims 10 and 30. There is absolutely no language in the “Top Ratings” section on page 13 of CHECKPOINT that suggests making all weightings equal to one another.



Therefore, claims 10 and 30 are not unpatentable over CHECKBOOK.

In addition with respect to claims 12 and 32, CHECKBOOK does not teach or suggest the feature: “wherein said comradery has a higher weight than any other rating factor utilized for generating said overall rating”.

The Examiner argues: “As per Claims 12 and 32, CHECKBOOK fails to expressly disclose wherein the rating factors include comradery experienced by users of the facility, and wherein said comradery has a higher weight than any other rating factor utilized for generating said overall rating... However, CHECKBOOK does disclose tracking the Friendliness of a Health Club (pg.4), and generating an overall rating of a Health Club through the use of subjectively weighted scoring system (pg. 13, Top ratings), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the weighting based on user preferences (pg.13, top rating, apply your own subjective judgments). ”

In response, Applicant respectfully contends that the “Top Ratings” section on page 13 of CHECKPOINT does not disclose the preceding feature claims 12 and 32. There is absolutely no language in the “Top Ratings” section on page 13 of CHECKPOINT that suggests assigning a higher rating to comradery than to any other rating factor.

Therefore, claims 12 and 32 are not unpatentable over CHECKBOOK.

In addition with respect to claims 17-20, 30, 32 and 37-40, the Examiner does not present any evidence or arguments to support the Examiner’s allegation that claims 17-20, 30, 32 and 37-40 are unpatentable over CHECKBOOK.

Therefore, claims 17-20, 30, 32 and 37-40 are not unpatentable over CHECKBOOK.

**35 U.S.C. § 103(a): CHECKBOOK- Claims 16 and 36**

The Examiner rejected claims 16 and 36 under 35 U.S.C. § 103 as allegedly being unpatentable over CHECKBOOK.

Since claim 16 respectively depends from claim 1, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintain that claim 16 is not unpatentable over CHECKBOOK under 35 U.S.C. §103(a).

Since claim 36 respectively depends from claim 21, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintains that claim 36 is not unpatentable over CHECKBOOK under 35 U.S.C. §103(a).

In addition with respect to claims 16 and 36, CHECKBOOK does not teach or suggest the feature: “wherein the plurality of inspectors includes a male inspector and a female inspector”.

The Examiner argues: “As per Claims 16 and 36, CHECKBOOK does not expressly show wherein the plurality of inspectors includes a male inspector and a female inspector... However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The facility assessment method/system would be performed regardless of the demographics of the inspector. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)... Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a variety of inspector demographics, to include a male inspector and a female inspector, because such data does not functionally relate

to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

In response, Applicant respectfully contends that the genders of male and female for the inspectors are: not nonfunctional descriptive data; and are functionally involved in the steps recited. The preceding feature of claims 16 and 36 further limit the “inspecting” step, because the inspecting step is required, by the combination of claims 1, 15, and 16 (as well as by the combination of claims 21, 35, and 36) to be performed by inspectors that include a male inspector and a female inspector.

Furthermore, CHECKBOOK does not teach or suggest that a subjective interpretation of the data means that the inspectors include a male inspector and a female inspector.

Therefore, claims 16 and 36 are not unpatentable over CHECKBOOK.

**35 U.S.C. § 103(a): CHECKBOOK In View of McLuhan-Claims 10, 12, 17-20, 30, 32, 37-40**

The Examiner rejected claims 10, 12, 17-20, 30, 32 and 37-40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over CHECKBOOK in view of McLuhan, (McLuhan, Robert, “Brands put service under the spotlight: Companies are enlisting mystery shoppers to test the quality of their offering,” Marketing, February 21, 2002).

Since claims 10, 12, and 17-20 depend from claim 1, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintains that claims 10, 12, and 17-20 are not unpatentable over CHECKBOOK in view of McLuhan under 35 U.S.C. §103(a).

Since claims 30, 32 and 37-40 depend from claim 21, which Applicant has argued *supra* to not be anticipated by CHECKBOOK under 35 U.S.C. §102(b), Applicant maintains that claims 30, 32 and 37-40 are not unpatentable over CHECKBOOK in view of McLuhan under 35 U.S.C. §103(a).

In addition with respect to claims 10,12, 30, and 32, the Examiner does not present any evidence or arguments to support the Examiner’s allegation that claims 10,12, 30, and 32 are unpatentable over CHECKBOOK view of McLuhan.

Therefore, claims 10,12, 30, and 32 are not unpatentable over CHECKBOOK in view of McLuhan.

In addition with respect to claims 19 and 39, CHECKBOOK in view of McLuhan does not teach or suggest the features: “wherein the at least one inspector has passed an examination

that tests knowledge of physical exercise, health, and dynamics of comradery”.

The Examiner argues: “As per Claims 17-20 and 37-40, CHECKBOOK fails to expressly disclose training and/or qualifying inspectors who are to perform said inspecting... However, McLuhan discloses the use of "mystery shoppers" for completing a detailed evaluation of a service establishment, to include Health Clubs. McLuhan also discloses the training of the operatives prior to completing the mystery shopping (pg. 1, gives set points to look for)... Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included training and/or qualifying inspectors who are to perform said inspecting, as disclosed by McLuhan in the system disclosed by CHECKBOOK, for the advantage of providing a method/system of assessing a facility, with the ability to ensure effective and quality evaluations (assessments/inspections) by providing trained staff to complete the surveys.”

In response, Applicant respectfully contends that the preceding argument by the Examiner presents no evidence allegedly demonstrating that McLuhan teaches or suggests the feature: “wherein the at least one inspector has passed an examination that tests knowledge of physical exercise, health, and dynamics of comradery”.

Therefore, claims 19 and 39 are not unpatentable over CHECKBOOK in view of McLuhan.

In addition with respect to claims 20 and 40, CHECKBOOK in view of McLuhan does not teach or suggest the feature: “wherein the at least one trained inspector is physically fit, has a physically fit appearance, and has passed a minimum strength test”.

The Examiner argues: “As per Claims 17-20 and 37-40, CHECKBOOK fails to expressly disclose training and/or qualifying inspectors who are to perform said inspecting... However, McLuhan discloses the use of "mystery shoppers" for completing a detailed evaluation of a service establishment, to include Health Clubs. McLuhan also discloses the training of the operatives prior to completing the mystery shopping (pg. 1, gives set points to look for)... Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included training and/or qualifying inspectors who are to perform said inspecting, as disclosed by McLuhan in the system disclosed by CHECKBOOK, for the advantage of providing a method/system of assessing a facility, with the ability to ensure effective and quality evaluations (assessments/inspections) by providing trained staff to complete the surveys.”

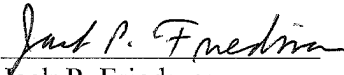
In response, Applicant respectfully contends that the preceding argument by the Examiner presents no evidence allegedly demonstrating that McLuhan teaches or suggests the feature: “wherein the at least one trained inspector is physically fit, has a physically fit appearance, and has passed a minimum strength test”.

Therefore, claims 20 and 40 are not unpatentable over CHECKBOOK in view of McLuhan.

### CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 19-0513.

Date: 10/09/2006

  
Jack P. Friedman  
Registration No. 44,688

Schmeiser, Olsen & Watts  
22 Century Hill Drive - Suite 302  
Latham, New York 12110  
(518) 220-1850